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09/868,801	06/21/2001	David Robert Fenn	OC-529	5080

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EXAMINER
SERGENT, RABON A

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 13

Application Number: 09/868,801

Filing Date: 06/21/2001

Appellant(s): Fenn et al.

Jacques B. Miles

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 25, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1, 2, 4, and 6-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

U. S. 4,322,508	Peng et al.	March 30, 1982
U.S. 4,379,906	Chattha	April 12, 1983
NL 9201868	van der Elshout et al.	May 16, 1994
WO 96/20968	Aerts et al.	July 11, 1996
WO 97/30099	Fenn et al.	August 21, 1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, and 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Appellants have specified that the coating composition is liquid; however, appellants have failed to specify the conditions at which the composition is liquid. Appellants' response has been considered; however, this issue is considered to be particularly relevant in view of the fact that coating compositions may be liquid at room temperature or solid at room temperature and liquid at elevated temperatures, as in the case of powder coatings. Furthermore, with respect to claim 10, it is unclear how to interpret the requirement that the composition be liquid and the optional requirement that the composition be dissolved in a solvent.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/30099 or NL 9201868.

The references disclose the production of coatings, wherein diphenylmethane diisocyanate is reacted with a polyester corresponding to the instantly claimed polyester containing secondary hydroxyl groups. See entire documents. The examiner has considered appellants' "no reactive diluent" language; however, it is noted that WO 97/30099 provides for diluents having amine groups which are considered to be outside the instantly claimed excluded species of the diluent. It is noted that claim 10 fails to exclude the presence of any component. With respect to appellants' argument that the composition of NL 9201868 is in the form of a binder for powder paints, the position is taken, in the absence of a temperature condition for the instantly claimed liquid composition, that the liquid requirement is met when the binder is heated and melted.

Claims 1, 2, 4, and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chattha ('906) or Peng et al. ('508) or WO 96/20968, each in view of WO 97/30099.

The primary references disclose coating compositions derived from the reaction of a polyisocyanate crosslinking agent with a polyester containing secondary hydroxyl groups, derived from the reaction of compounds containing carboxyl groups with epoxides.

While the references teach the use of epoxides to produce the secondary group containing polyesters, the references are silent regarding the use of appellants' claimed glycidyl ester of C_{11}-C_{20} alkanoic acid as the epoxide. However, the use of such epoxides to produce secondary group containing polyesters for use within isocyanate cured coating compositions was known at the time of invention. This position is supported by the teachings of WO 97/30099 at page 6, lines 35-37.

Therefore, the position is taken that it would have been obvious to utilize the claimed epoxide within the primary references, so as to arrive at the instant invention, because it has been held that it is *prima facie* obvious to utilize a component for its known function. In re Linder, 173 USPQ 356. In re Dial et al., 140 USPQ 244. One would have reasonably expected the use of the claimed epoxide to yield compositions having properties analogous to the properties of the compositions of the primary references.

With respect to the anticipation rejection and the obviousness rejection, the examiner has considered the effect of the argued transitional phrase, "consisting essentially of", as set forth within claims 1 and 11. The position is taken that appellants have failed to establish, by such means as rationale or evidence, that the argued additional components of the references would

have a material effect on the compositions and would, therefore, be excluded from the claims. It is noted that claim 10 is devoid of the argued transitional phrase.

*(11) **Response to Argument***

Appellants' arguments have been addressed within the ***Grounds of Rejection***.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

RABON SERGENT
PRIMARY EXAMINER

R. Sergent
May 16, 2003

Conferees

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